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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,463	02/17/2004	Steven D. Goedeke	P-11547.00	1783

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MEDTRONIC, INC.
710 MEDTRONIC PARK
MINNEAPOLIS, MN 55432-9924

EXAMINER

FLORY, CHRISTOPHER A

ART UNIT	PAPER NUMBER
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3762

MAIL DATE	DELIVERY MODE
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12/21/2006

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/781,463

Applicant(s)

GOEDEKE, STEVEN D.

Examiner

Christopher A. Flory

Art Unit

3762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-15.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant argues that Velez'765 does not teach in the broadest reasonable interpretation a device that includes the optional incorporation of a programmable memory into a functioning implantable medical device. However, changing the claim language from "exclude" to "does not include" does not by itself necessitate the physical removal of the RAM unit from the implanted medical device to consider the RAM to not be included. Merely not reading instructions from the RAM unit, as taught in Velez'765, is still sufficient within a reasonable interpretation of the claim language to constitute "not including" the RAM unit. Even though the Velez'765 invention does physically present both RAM and ROM in both device phases, the exclusion of the RAM unit during the second phase with regard to providing operating instructions to the device is considered an exclusion of the RAM.

In light of Applicant's arguments that Velez'765 teaches that it would be undesirable to physically remove the RAM, omission of an element and its function is obvious when the function of the element is not desired (Ex parte Wu, 10 USPQ 2031 (Bd. Pat. App. & Inter. 1989); In re Kuhle, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)). In this case, to not include the RAM module in the second product phase, whether by physical removal or by not using operating instructions stored within the RAM module that is still present, is an obvious expedient when the RAM module and its function are not desired.

Therefore, whether it is considered that to "not include" the RAM in the subsequent product model can only be interpreted as meaning the physical removal of the RAM from said model, or whether it may also encompass the interpretation that not including the instructions stored on the RAM in the subsequent model is sufficient, Velez'765 makes a sufficient case of obviousness to reject the claims of the instant application.

Applicant's position that the second phase device of their invention is an entirely new and different device than that in the first phase, and that the second phase device never contained RAM in the first place, contrary to their assertion, does not read implicitly in the claim language. Further, Attorney's statement on page 3, paragraph 2 that "RAM may be present in the devices for other purposes and the claims do not exclude the presence of RAM in either build" seems to further support the Examiner's position, as the RAM that is present in Amely-Velez is indeed still present but used for a different functions in the second embodiment of the device.